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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,704	02/04/2004	Kazumasa Ushiki	FUJH 20.907	3759
26304 7590 05/21/2007 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER WIN, AUNG T	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/771,704

Applicant(s)

USHIKI ET AL.

Examiner

Aung T. Win

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/01/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 2, 12, 27, 29, 36 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-26, 28, 30-35, 37 & 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed on FEB 28 2007 have been fully considered but they are not persuasive.

Regarding Claim 1, Applicant argues that Chen et al. do not disclose or suggest the claimed feature of transmitting terminal identification information and a terminal address together with user identification information. Examiner disagrees. As stated below in office action of claim 1 rejection, Chen discloses transmitting terminal id and terminal address together with user identification information i.e., each terminal disclosed by Chan is configured to transmit **read token ID associated with user (user identification information) and context data: [0025]** wherein **context data comprises terminal identifier and terminal location indication i.e., claimed terminal address: [0019, 0025, 0026]** [also see service manager 12 personalize data based on received user tag ID and context data and further transmitting the personalized data: 0027]. Therefore, applicant's argument is not persuasive.

Regarding Claim 28, Applicant argues that Chen et al. do not suggest the claimed feature of a home agent address management server. Examiner recognizes that Chen et al. do not explicitly teach the claimed feature of a home agent address management server. But Modified system and method as stated below in Claim 28 rejection would teach the claimed feature of a home agent address management server. Therefore, applicant's argument is not persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a terminal sending a **user identification information**" in Line 2, Claim 1 and the limitation "sends the **read user identification information** to the messaging server" in Line 8, Claim 1.

Claim 1 later recites "sends the stored terminal identification information and the terminal address to the messaging server together with **the user identification information**" in Line 11, Claim 1 and "the terminal address related with **the user identification information**" in Line 14, Claim 1. There is insufficient antecedent basis for this limitation "**the user identification information**" in the claim because it is unclear if the user identification information is referring to the user identification information cited in Line 2, Claim 1 or the read user identification information cited in Line 8, Claim 1 although it appears to examiner that they all are referring to the same user identification information.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 7, 8, 13, 16-22, 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al. (US20040203638A1).

2.1 Regarding Claim 1, Chan discloses a messaging system [Figure 1: 0018-0021] comprising:

A terminal sending a user identification information of a user using the terminal [Terminal 14 or 16 with RF tag reader sending read token identifier associated with user: 0008, 0022, 0025 & 0026] [Terminal 14 or 16: Figure 3] [Handheld Terminal: 0047, 0048, Figure 6A]; and

Messaging server (Service Management Node integrated with local content database, remote content database, and other content servers) holding content which corresponds to the user identification information of the user, and delivering the content on a receipt of the user identification information sent from the terminal [transmitting locally stored or remotely stored personalized data corresponding to read token identifier associated with user: 0019, 0026, 0027] [Service Manager personalize data based upon read token identifier associated with user and context data received from the transmitting terminal wherein context data comprises terminal identifier and terminal location indication: 0019, 0025, 0026]; wherein

By wirelessly communicating with a wireless tag which is carried by the user and which stores the user identification information of the user, the terminal reads the user

identification information from the wireless tag and sends the read user identification information to the messaging server [Terminal with Token reader reads token ID associated with user and transmit the read token ID: 0008, 0009, 0025, 0026 & 0027] [terminal reader is operable to read token ID wirelessly: 0022].

Chen also discloses that each terminal is configured to transmit to service manager 12 read token ID associated with user and context data: [0025] wherein context data comprises terminal identifier and terminal location indication i.e., claimed terminal address: [0019, 0025, 0026] [also see service manager 12 personalize data based on received user tag ID and context data and further transmitting the personalized data: 0027]. Therefore, Chen's terminal must stores in advance terminal identification information and a terminal address of the terminal and sends the stored terminal identification information and the terminal address to the messaging server together with the user identification information as claimed.

Registration step as claimed must be inherently executed in Chen's system in order to determine terminal that user is associated with to provide personalized data [also see scheduled service to provide personalized data in later time: 0031].

2.2 Claim 25 is rejected for the same reason as stated above in Claim 1 rejection [See Claim 1 rejection] because claimed message server substantially read on Chen's messaging server as stated above in Claim 1. Claimed memory unit, reception unit and delivery unit are inherently implemented in Chen's messaging server as stated above in order to perform data transmission and reception.

2.3 Claim 26 is rejected for the same reason as stated above in Claim 1 rejection [See Claim 1 rejection] because claimed terminal substantially read on corresponding terminal of Claim 1. Claimed units are inherently implemented in the terminal as stated above in Claim 1 rejection is configured to transmit and receive data and also configured to process multimedia data [data: 0019].

2.4 Claim 27 is also rejected for the same reason as stated above in Claim 1 rejection [See Claim 1 rejection]. The terminal used by user as stated above in Claim 1 rejection comprises RF-ID tag reader as claimed which wirelessly communicates with a wireless tag storing user identification information in advance, and reads the user identification information stored in the wireless tag, wherein the transmission unit transmits user identification information read by the read unit.

2.5 Regarding Claim 7, Chan also discloses passive RF Tag, which can only be powered by RF tag reader [0022].

2.6 Regarding Claim 8, Chan discloses that RF tag and RF tag reader are operating in predetermined range [See Figure 3].

2.7 Claim 13 is rejected for the same reason as stated above in Claim 1 rejection.

Chan discloses that information provided to user is based on read user tag ID and terminal ID in which user is using [context data or terminal ID: 0008, 0025-0030].

2.8 Regarding Claim 16, Chan discloses providing information stored in the content server i.e., email server or corresponding message server [0033 & 0034].

2.9 Claims 17, 18, 19 & 20 are rejected for the same reason as stated above in Claim 16. Chan messaging system must have claimed limitations because Chan discloses providing messaging services based such as scheduled service [0031 & 0032] and news service [0037 & 0038].

2.10 Claims 21 & 22 are also rejected for the same reason as stated above in Claim 1 rejection. Chan messaging system must have claimed limitations because Chan messaging system provides personalized information based on specific user preferences [0038] and Chan messaging system provide information to multiple users [0027].

2.11 Claim 24 is rejected for the same reason as stated above in Claim 1 rejection. Chan discloses that user terminal and messaging server are communicating via service manager 12 i.e., server computer 80 [Figures 1, 4 & 5] [0046] (claimed management

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server) wherein messaging server is integrated with user profiles database 36 for accessing user mail server (claimed messaging server).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 & 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of Fukuda (US20020116268A1).

3.1 Regarding Claim 3, Chan discloses all the limitations as stated above in Claim 1 rejection. Chan fails to disclose storing messaging server identification information in addition to the user identification information.

Fukuda discloses information providing system comprising RF-ID tag storing address of the network server that is to be accessed, RF-ID reader implemented in the portable terminal reading the stored address of the network server from RF-ID tag to further access the information from the network server [Summary] [RFID system: 0035-0037] [portable terminal: 0038-0043 & 0052-0082] [RF-ID Tag: 0044-0051]. Fukuda

also teaches storing email address in the RF-ID tag for accessing mail server via the portable terminal [0103-0114] [Figures 1-6].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Chan's messaging system to install messaging server address information in the RF-ID tag as taught by Fukuda to process as claimed. One of ordinary skill in the art would have been motivated to do this to provide improved messaging system for user convenience [Fukuda: 0113]

3.2 Claim 4 is also rejected for the same reason as stated above in Claim 3 rejection.

Fukuda teaches reading the stored information from the RF-ID tag by user [setting portable information terminal to information receive entry mode: 0065-0074].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify Chen's handheld terminal implemented with RF-ID tag reader as stated above for receiving RF-ID tag information based on user action as taught by Fukuda to modify as claimed. One of ordinary skill in the art would have been motivated to do this to provide improved user interface for user convenience.

4. Claims 5, 6, 9, 10, 11 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of Gruteser et al. (US20030037243A1).

4.1 Regarding Claims 5, Chan teaches RF-ID tag reader reading the user ID from the RF-ID tag. Chan does not explicitly disclose reading the user ID periodically.

Gruteser discloses RF-ID reader reading the identification information from RF-ID tag periodically and further updating the read information [0039]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Chan's RF-ID tag reader to read identification information from tag periodically as taught by Gruteser to modify and program RF-ID reader as claimed. One of ordinary skill in the art would have been motivated to do this to implement improved system so that providing wrong information to specific user can be avoided.

4.2 Claims 6, 9, 10, 11 & 14 are rejected for the same reason as stated above in Claim 5 rejection. At the time of invention of made, it is obvious to skill in the art that RF-ID readers can be programmed to utilize according to various applications as needed; moreover such claimed features are expected in the RF-ID reading applications. One of ordinary skill in the art would have been motivated to do modify as claimed to ensure the system with improved security and accuracy.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1).

5.1 Regarding Claim 15, Official Notice is taken that Chan's terminal does not explicitly disclose format conversion as claimed. Official Notice is taken that concept and advantages of such claimed feature is well-known to one skill in the art at the time

of invention of made in order to provide formatted version according to user terminal capability. Therefore, claimed feature is obvious to one skill in the art at the time of invention of made and it is also expected in the data transmission art. Therefore reformatting as claimed do not constitute a patentably distinct limitation.

6. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of Katagishi et al. (US20030120745A1).

6.1 Regarding Claim 23, Chan discloses providing subscribed messaging services [0027] but does not explicitly disclose charging the user for provided information based on the delivery count.

Katagishi discloses information providing system and the method comprising tracking access count per user [0076]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Chan's messaging server to implement user access count tracking feature as taught by Katagishi to modify as claimed. One of ordinary skill in the art would have been motivated to do this provide improved information providing system for service provider.

7. Claims 28, 30-35 & 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US20040203638A1) in view of admitted prior art [0006].

7.1 Regarding Claim 28, Chan discloses a messaging system [Figure 1: 0018-0021] comprising a terminal sending a user identification information of a user using the

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terminal [Terminal with Token reader i.e., RFID tag reader: 0008, 0022, 0025]
[Handheld Terminal: 0047 & 0048].

Chan also discloses the terminal wirelessly communicating with a wireless tag which is carried by the user and which stores the user identification information of the user, the terminal reads the user identification information from the wireless tag and sends the read user identification information to Service Management Node [Terminal with Token reader reads token ID associated with user and transmit the read token ID: 0008, 0009, 0025, 0026 & 0027] [terminal reader is operable to read token ID wirelessly: 0022].

Chan does not explicitly disclose a home agent address management server as claimed. But Chan discloses Service Management Node integrated with local content database, remote content database, and other content servers holding content which corresponds to the identification information of the user as stated above in Claim 1 rejection [incase of email application, holding email server address associated with user identification information: 0027]. Chan uses providing email content as an example wherein Chan teaches that Service Management Node provides the personalized content by

Retrieving the stored content server address associated with identification information of the user on a receipt of the user identification information sent from the terminal;

Accessing the content server using retrieved content server address;

Delivering the retrieved content to the terminal [Message Service: 0033 & 0034].

Chan does not explicitly disclose home agent server however such entity is expected in Chan's messaging system because Chan teaches that the terminal comprises mobile client terminals [0047]. At the time of invention of made, it is obvious to one of ordinary skill in the art that Wireless mobile terminals as taught by Chan are configured to process wireless data communication and web service application such as retrieving web content data by using integrated web browser applications via home agent server as claimed.

Chan also discloses admitted prior art wherein the prior art teaches receiving Web URLs for further requesting the content information [0006] based on received Web URLs using terminals.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Service Management Node as claimed home agent address management server as taught by admitted prior art for storing content URL and returning content URL based on receipt of user identification information. One of ordinary skill in the art would have been motivated to do this to provide flexible and dynamic information content distribution method.

7.2 Claim 35 is rejected for the same reason as stated above in Claim 28 rejection.

It is obvious that modified terminal comprises processors integrated with first transmission unit and first reception unit for transmitting User ID and receiving Web URL as stated above in Claim 28; and second transmission unit and second reception unit for accessing content based on Web URL for processing web service application.

7.3 Claim 37 is rejected for the same reason as stated above in Claim 28 rejection.

As stated above, modified system comprises claimed content server such as web server or email server for providing requested personalized information to the users associated with wireless terminals. Therefore, it is obvious to one skill in the art that content server employed in modified system would comprises

Memory unit as claimed because the contents stored in server must be associated with user identification information for determining and providing personalized emails based on received user identification information;

Content sending unit and receiving unit as claimed because content sending unit needs to query home agent server for transmitting contents to wireless terminals;

User identification information transmitting unit as claimed in order to determine home agent server that the user is registered with for providing requested personalized information to the users associated with wireless terminals.

7.4 Claim 39 is also rejected for the same reason as stated above in Claims 28 and 37 rejections. As stated above, it is obvious to one of ordinary skill in the art that modified system comprises home agent server for providing wireless communication services between wireless end entities for providing communications between end systems and wireless devices. Therefore, home agent server implemented in modified system would comprise a user identification information reception unit, a control reception unit and forwarding unit for routing information to appropriate destination.

7.5 Regarding Claims 30-34, modified terminal is capable of accessing information by browsing or accessing wirelessly based on received URLs as stated above. It is obvious to one skill in the art at the time of invention of made that modified system would have comprises claimed steps as stated in Claims 30-34 because modified terminal is configured to access or browse the requested information based on received URLs.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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May 3, 2007


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